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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,106

08/21/2003

Gianpietro Invernizzi

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7270

22474

7590

11/23/2004

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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/645,106

Applicant(s)

INVERNIZZI ET AL.

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 13 state that the specialized coating is “nonadhesive.” However, support for this term cannot be found in the specification. In fact, it would appear that the specification teaches the opposite as outlined in the following 112, second paragraph rejection.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 13, applicant recites that the specialized coating is “nonadhesive.” However, on page 7, lines 3-11, applicant states that the coating can be applied to the metal backed blanket by methods such as thermowelding, plastic spray on treatments or plasma

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treatment. These methods would appear to be methods used to adhere the plastic to the metal backed blanket. Furthermore, in lines 8-9 of this page, applicant describes the coating as a "plastic adhesive foil." This would appear to indicate that the specialized coating, in fact, is adhesive.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 9-13 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646).

With respect to claims 1 and 13, Castelli et al. discloses the claimed metal backed printing blanket and the method of making the same except for the specialized coating. Castelli et al. discloses a printing blanket with a thin metal base plate 18, with a top and bottom surface and a leading and trailing edge for engaging a cylinder gap as shown in Figures 1-2 and 4B of Castelli et al. Further disclosed by Castelli et al. is a compressible, elastomeric printing blanket 12 which includes compressible layer 30 (col. 6, lines 16-27) and elastic layer 34 (Castelli et al., col. 7, lines 11-13). Buono et al. teaches a printing blanket with a metallic inner sleeve and a specialized coating on its internal diameter (Buono et al., paragraph [0045], lines 12-13). It would have been obvious to combine the teaching of Buono et al. with the printing blanket

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disclosed by Castelli et al. for the advantage of providing friction between the inner surface of the printing blanket and the roller on which it is mounted ensuring that the blanket does not slip.

With respect to claim 2, applicant has not recited any further structure in this claim so it is rejected along with its parent claim.

With respect to claims 9 and 21, Castelli et al. discloses providing an anti-slip layer on the top portion of the base plate in col. 3, lines 37-39.

With respect to claims 10 and 22, Castelli et al. discloses a sealant applied along the edges of the blanket in col. 3, lines 12-15.

With respect to claims 11 and 23, in col. 7, lines 59-67, Castelli et al. discloses that the sealant 36 can be a nitrile polymer.

With respect to claims 12 and 24, Castelli et al. discloses that the blanket has a compressible layer 30 beneath the upper face and a fabric layer 28 as described in col. 3, lines 23-30 of Castelli et al.

7. Claims 3, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646), as applied to claims 1-2, 9-13 and 21-24 above, and further in view of Rosvold (US 3,705,072).

With respect to claims 3 and 5, Castelli et al. in view of Buono et al. discloses the claimed printing blanket except that the thickness of the specialized coating is not known to the examiner. However, the optimal thickness of the specialized coating is an obvious matter that could have been determined by one of ordinary skill in the art through routine experimentation. Additionally, Rosvold teaches that it is known to apply a coating with a thickness of 2 mils (50.8

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$\mu\text{m}$ ) to the underside of a rubber blanket (see the table in col. 6, and lines 53-61 of Rosvold).

With respect to the recitation of thermowelding, it is noted that this is an apparatus claim and the method of applying the coating has no patentable weight in an apparatus claim.

With respect to claim 7, in the table in col. 6, Rosvold also discloses a thickness of 0.6 mil (15.24  $\mu\text{m}$ ) for the underside coating or the blanket, as mentioned above, the method of applying the coating has no patentable weight in an apparatus claim.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646) as applied to claims 1-2, 9-13 and 21-24 above, and further in view of Berna et al. (US 5,347,927).

Castelli et al. in view of Buono et al. discloses the claimed invention except that it is not known to the examiner what the specialized coating is comprised of. However, Berna et al. teaches a coating on the inner surface of a carrier tube of a printing blanket made of polyurethane (Berna et al., col. 12, lines 18-32). Berna et al. further discloses in col. 12, lines 35-40 that "the adhesives may also be encapsulated in a coating material which permits the blanket and/or carrier to be conveniently slid onto a cylinder or core, and which, when broken, crashed, dissolved, or otherwise ruptured, provides tackiness whereby rotational slippage of the blanket is minimized during operation." It would have been obvious to combine the teaching of Berna et al. with the printing blanket disclosed by Castelli et al. in view of Buono et al. for the advantage of easily sliding on the printing blanket and only activating the adhesiveness when it is properly positioned.

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9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646), and Rosvold (US 3,705,072) as applied to claims 3, 5, and 7 above, and further in view of Brookfield (US 5,941,172).

Castelli et al. in view of Buono et al. and Rosvold discloses the claimed printing blanket except that it is not known what the coating is comprised of. However, Brookfield teaches a printing blanket with an innermost coating of polytetrafluoroethylene (Brookfield, col. 3, lines 48-55, Figure 3). It would have been obvious to combine the teaching of Brookfield with the printing blanket disclosed by Castelli et al. in view of Buono et al. and Rosvold for the advantage avoiding potential problems of contamination (Brookfield, col. 1 lines 42-46).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646) as applied to claims 1-2, 9-13 and 21-24 above, and further in view of Buono et al. (US 2003/0116044).

Castelli et al. in view of Buono et al. '646 discloses the claimed method of making a printing blanket except that it is not known to the examiner how the specialized coating is applied. However, Buono et al. '044 teaches that it is known to spray coatings onto a metal printing sleeve (Buono et al. '044, paragraphs [0056]-[0058]). It would have been obvious to combine the teaching of Buono et al. '044 with the method of making a printing blanket disclosed by Castelli et al. in view of Buono et al. '646 for the advantage of the reduction of rogue cells and faster spraying time (Buono et al. '044, paragraph [0016]).

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11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646) as applied to claims 1-2, 9-13 and 21-24 above, and further in view of Riskey et al. (US 2003/0129896).

With respect to claim 14, Castelli et al. in view of Buono et al. discloses the claimed method of making a printing blanket except that it is not known to the examiner how the specialized coating is applied. However, Riskey et al. teaches attaching the layers of a printing blanket through heating (thermowelding) (Riskey, page 1, paragraph [0008]). It would have been obvious to combine the teaching of Riskey et al. with the method of making a printing blanket disclosed by Castelli et al. in view of Buono et al. for the advantage of not using solvents to combine the layers which can be unpleasant to use and damaging to the environment.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646) and Riskey et al. (US 2003/0129896) as applied to claim 14 above, and further in view of Rosvold (US 3,705,072).

Castelli et al. in view of Buono et al. and Riskey et al. discloses the claimed printing blanket except that the thickness of the specialized coating is not known to the examiner. However, the optimal thickness of the specialized coating is an obvious matter that could have been determined by one of ordinary skill in the art through routine experimentation. Additionally, Rosvold teaches that it is known to apply a coating with a thickness of 2 mils (50.8  $\mu\text{m}$ ) to the underside of a rubber blanket (see the table in col. 6, and lines 53-61 of Rosvold).

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13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646) and Risquez et al. (US 2003/0129896) as applied to claims 14-15 above, and further in view of Berna et al. (US 5,347,927).

Castelli et al. in view of Buono et al. and Risquez et al. discloses the claimed invention except that it is not known to the examiner what the specialized coating is comprised of. However, Berna et al. teaches a coating on the inner surface of a carrier tube of a printing blanket made of polyurethane (Berna et al., col. 12, lines 18-32). Berna et al. further discloses in col. 12, lines 35-40 that “the adhesives may also be encapsulated in a coating material which permits the blanket and/or carrier to be conveniently slid onto a cylinder or core, and which, when broken, crashed, dissolved, or otherwise ruptured, provides tackiness whereby rotational slippage of the blanket is minimized during operation.” It would have been obvious to combine the teaching of Berna et al. with the printing blanket disclosed by Castelli et al. in view of Buono et al. and Risquez et al. for the advantage of easily sliding on the printing blanket and only activating the adhesiveness when it is properly positioned.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646) and Buono et al. (US 2003/0116044) as applied to claim 14 above and further in view of Rosvold (US 3,705,072).

Castelli et al. in view of Buono et al. ‘646 and Buono et al. ‘044 discloses the claimed method of making a printing blanket except that the thickness of the coating is not known to the examiner. However, the optimal thickness of the specialized coating is an obvious matter that could have been determined by one of ordinary skill in the art through routine experimentation.

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Additionally, Rosvold teaches that it is known to apply a coating with a thickness of 2 mils (50.8  $\mu\text{m}$ ) to the underside of a rubber blanket (see the table in col. 6, and lines 53-61 of Rosvold).

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646) applied to claims 1-2, 9-13 and 21-24 above and further in view of Jenkins et al. (US7,793,041).

Castelli et al. in view of Buono et al. '646 discloses the claimed method of making a printing blanket except that it is not known to the examiner how the specialized coating is applied. However, Jenkins et al. teaches that it is known apply a coating by plasma treatment onto a printing sleeve (Jenkins et al., col. 4, lines 1223). It would have been obvious to combine the teaching of Jenkins et al. with the method of making a printing blanket disclosed by Castelli et al. in view of Buono et al. for the advantage of applying extremely thin layers as afforded by plasma treatment.

16. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castelli et al. (US 5,749,298) in view of Buono et al. (US 2003/0045646) and Jenkins et al. (US7,793,041 applied to claim 14 above and further in view of Rosvold (US 3,705,072).

Castelli et al. in view of Buono et al. and Jenkins et al. discloses the claimed printing blanket except that the thickness of the specialized coating is not known to the examiner. However, the optimal thickness of the specialized coating is an obvious matter that could have been determined by one of ordinary skill in the art through routine experimentation.

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Additionally, Rosvold teaches that it is known to apply a coating with a thickness of 2 mils (50.8  $\mu\text{m}$ ) to the underside of a rubber blanket (see the table in col. 6, and lines 53-61 of Rosvold).

***Allowable Subject Matter***

17. Claims 8, 18 and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. Applicant's arguments filed 9/15/04 have been fully considered but they are not persuasive of any error in the above rejection.

With respect to applicant's arguments regarding § 35 U.S.C. 103(c), the examiner respectfully disagrees with applicant's assertion that Buono et al. does not qualify as prior art under 102(a). The Buono et al. (US 2003/0045646) reference does indeed qualify as prior art under 102(a). 102(a) states that:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Buono et al. was published in this country on March 6, 2003 and applicant's filing date is August 21, 2003, thus Buono et al. was known by others in this country before the invention thereof by applicant. Since Buono et al. *does* qualify under 102(a) it is available as prior art, with respect to 103(c).

With respect to applicant's assertion that Buono et al. teaches an adhesive coating, it is not clear to which particular aspect applicant is referring. No reference to adhesion properties of

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the coating can be found in Buono et al. It would not appear to be adhesive except to the extent that it adheres, as any coating does, to a surface to which it is applied. It would appear that applicant's coating would also have such an adhesive property, particularly in view of the use of the term plastic adhesive on page 7 of applicant's specification.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

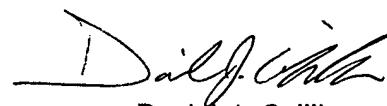
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 18, 2004



**Daniel J. Colilla**  
**Primary Examiner**  
**Art Unit 2854**